UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,974	05/20/2004	Heiko Rommelmann	A2132Q-US-NP	8641

			EXAMINER
25453	7590	01/24/2006	WALSH, DANIEL I

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/849,974	ROMMELMANN ET AL.
	Examiner	Art Unit	
	Daniel I. Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>5-04</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Receipt is acknowledged of the IDS received on 20 May 2004. The Examiner has not

considered the four listed copending Patent Applications because the IDS fails to list the serial

numbers. Appropriate clarification/correction is required.

Specification

2.   The disclosure is objected to because of the following informalities:

In paragraph [0001] reference is made to 3 copending Patent Applications, but the serial

numbers are not provided (XX/XXX,XXX is provided).

Re page 19, line 6: Replace "information it" with -- information --.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in
public policy (a policy reflected in the statute) so as to prevent the unjustified or improper
timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is
appropriate where the conflicting claims are not identical, but at least one examined application
claim is not patentably distinct from the reference claim(s) because the examined application
claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g.,
In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re
Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ
619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).

3.   Claims 1-3, 7, 8, 11, 12, 18, and 19 are provisionally rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claims 8 -10 of

copending Application No. 10/849,973 and claims 1-3 and 18-19 are provisionally rejected on

the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims

1, 5, 7, and 9 of copending application No. 10/849,976. Although the conflicting claims are not

identical, they are not patentably distinct from each other because both are drawn towards a

method of processing a module, including verifying information and then writing/storing a first

or second type of information in the tag after verification, and are not patentably distinct from

each other.

I) Re claim 1 of the present Application the Applicants claim: "…electronic module

tag…verifying…matches…. first programmable configuration or the second

programmable configuration." (see claim 1), whereas in the '973 Application the

Applicants claim: "…electronic tag…verifying…matches…first module information or

second module information…" (see claim 8).

II) Re claim 18 of the present Application the Applicants claim: "…tag reader…verifying

that the tag identification information…configuration information…tag writer…" (see

claim 18), whereas in the '973 Application the Applicants claim:

"…reading…verifying…selectively storing…" (see claim 8). Though silent to a tag

writer, and producing configuration information, the Examiner notes that a tag writer is obvious in order to write/store the data in the tag, which is broadly interpreted to include producing the information.

III) Re claim 1 of the present Application the Applicants claim: "…tag…module identification information…verifying…if the module identification information matches…selectively programming… (see claim 1), whereas in the '976 Application the Applicants claim: "…tag…verifying…if the tag identification data matches…selectively programming…" (see claim 1 and 2).

IV) Re claim 18 of the present Application the Applicants claim: "..tag reader….verifying…tag writer.." (see claim 18), whereas in the '976 Application the Applicants claim: "tag writer…tag reader…verifier…program…" (see claim 9). Though the '976 Application is silent to producing configuration information, the Examiner has interpreted the writing/programming of the data to include production.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-3, 6-10, and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by

Dix et al. (US 2005/0099265).

Re claim 1, Dix et al. teaches providing a module (key) with an electronic module tag

comprising a tag memory, electronically obtaining module information from the module tag,

verifying the module identification information matches predetermined identification criteria,

and if the module identification information matches the predetermined identification criteria,

selectively programming the module tag either the first programmable configuration of the

second programmable configuration (FIG. 4, where the Examiner notes that a key is inserted into

a programmer where module identification information is obtained from the communication

circuit, interpreted as a tag with memory, verification is performed (paragraph [0061]), and if

matches a fleet code is transmitted to the master key, which is interpreted as a first or second

programmable configuration).

Re claim 2, the Examiner notes that the module is provided with the module tag (they are

integrated).

Re claim 3, The Examiner has interpreted that first programmable information is

programmed if a first configuration step is provided and a second programmable configuration if

a second configuration step is provided can be interpreted to include programming the module

new/different fleet codes into the master key.

Re claim 6, wireless communication has been discussed above (see FIG. 4).

Re claims 7-8, the Examiner notes that as the as disclosed as an RFID device the

Examiner notes that interrogation/answer is provided over wireless/contactless link. Re claim 7,

the Examiner has interpreted the identification request and calculating of an identification

response thereto to be shown by FIG. 4, which teaches querying and answering. The Examiner

has interpreted "calculate" to mean provide a response.

Re claims 9-10, the Examiner notes that it has been discussed above that a master key is

confirmed. This is interpreted as verifying that the tag is authorized by predetermined

programming permissions.

Re claim 18, the limitations have been discussed above (FIG. 4).

Re claim 19, it has been discussed above that writing only occurs if a master key is

verified. This is interpreted as matching identification criteria.

5.   Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Petteruti et al.

(US 6,409,401).

Re claim 1, Petteruti et al. (US 6,409,401) teaches a module with an electronic module

tag with a memory, electronically obtaining module identification information

(address/identifier) from the tag, verifying that the information matches predetermined

identification criteria, and selectively programming the module tag with either the first or second

programmable configuration (see FIG. 3).

Re claim 2, the module is interpreted as the media 14, and the information is obtained

after the module is provided with the tag.

Re claim 3, the Examiner notes that first configuration setup information or second

configuration setup information is broadly interpreted to include first or second RFID

address/identifiers. Accordingly, based on the address information, different configuration setup

information is therefore provided (different addresses/identifiers) and therefore different

configurations are programmed (different information).

Re claims 4-5, the Examiner notes that STEP 57 teaches if the RFID address read is

valid, and if so, it will continue on the programming, and if not, programming will be stopped.

This is interpreted as determining if the setup information is authorized for the obtained module

identification information or not.

Re claim 6, RFID (wireless/contactless) communication is taught (abstract).

Re claim 7, the Examiner has interpreted reading of the RFID tag address/identifier to

read upon the claim limitations.

Re claim 8, wireless communication has been discussed above.

Re claims 9-10, the use of a valid RFID tag address/identifier is interpreted as verifying

the tag is authorized by predetermined programming permissions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under

35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.   Claims 4-5 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dix

et al., as discussed above, in view of Petteruti et al. (US 6,409,401).

Re claims 4-5, the limitations of Dix et al. have been discussed above.

Dix et al. are silent to determining if the provided configuration setup information is

authorized for the module identification information.

Petteruti et al. teaches such limitations as STEP 57 teaches if the RFID address/identifier

read is valid, and if so, it will continue on the programming, and if not, programming will be

stopped. This is interpreted as determining if the setup information is authorized for the obtained

module identification information or not.

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to combine the teachings of Dix et al. with those of Petteruti et al.

One would have been motivated to do this in order to program/configure the module tag

only if authorized (if the identifier/address is valid).

Re claim 13, the limitations have been discussed above re claims 4-5. The Examiner

notes that the use of authentication information has been discussed above an obvious expedient

in order to authorize before RFID are encoded.

Re claim 14, the Examiner notes that as different tags can be encoded differently, the

Examiner notes tat different module identification information would result in different

programming, and thus first and second programming based on the uniqueness of the labels, is

an obvious expedient.

Re claim 15, the limitations have been discussed above re claim 3.

Re claims 16-17, the limitations have been discussed above re claims 7-8.

7.   Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarchow

et al. (US6,597,465).

Re claim 1, Jarchow et al. teaches such limitations (FIG. 18 and FIG. 19, where a RF tag

has module identification information obtained therefrom, verified, and then the RF tag has its

parameters set so that it can be programmed with a configuration). Though silent to a module,

the Examiner notes that a having the tag attached to a module would have been an obvious

expedient, as a means to label/identify a product or object, as is known in the art.

Re claim 18, the limitations have been discussed above. Though silent to producing

configuration information, Jarchow teaches that the reader 44' can write information, and that

after the RF tag parameters are set, that writing can be performed or not, based on the

parameters.

Therefore, it would have been obvious to one of ordinary skill in the art to create

configuration information that is written to the tag in order to program the tag for use, as is

known in the art.

8.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jarchow et al., as

discussed above, in view of Petteruti et al.

Re claim 13, the teachings of Jarchow have been discussed above.

Jarchow is silent to determining if the provided configuration setup information is

authorized for the module identification information.

Petteruti et al. teaches such limitations as STEP 57 teaches if the RFID address/identifier

read is valid, and if so, it will continue on the programming, and if not, programming will be

stopped. This is interpreted as determining if the setup information is authorized for the obtained

module identification information or not.

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to combine the teachings of Jarchow. with those of Petteruti et al.

One would have been motivated to do this in order to program/configure the module tag

only if authorized (if the identifier/address is valid).

9.   Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dix et al.,

as discussed above.

Dix et al. teaches an interface 304. The Examiner notes it would have been obvious for

the interface to provide audible/visual information, as is conventional in the art. Dix et al.

teaches (FIG. 4) that a user selects enrollment mode (user input) and that the processor

determines whether the configuration setup information is authorized for the identification

information (whether the selection of enrollment is authorized for the identification information

(only if the key is a master). Though silent to notifying when authorized, the Examiner notes it

would have been obvious to provide audible/visual notification to provide information to the user

about the process at hand.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure: Rankin et al. (US 6,028,518), Hohberger et al. (US 6,969,134), Berquist et al. (US

2001/0008390), Umehara et al. (US 2005/0068152), Dickinson et al. (US 2005/0128051),

Chapman et al. (US 2005/0230479), Murofushi et al. (US 2005/0234587), Wiklof et al. (US

6,246,326), Matthewson et al. (US 2005/0073416), Chung (US 2003/0029350), and Jusas et al.

(US 2005/0029350).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The

examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
1-16-06